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| APPLICATION NO.        | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |
|------------------------|-------------|----------------------|-----------------------|------------------|
| 10/637,177             | 08/07/2003  | Katsumi Yamamoto     | 39611-8012US1         | 3922             |
| 25096                  | 7590        | 10/12/2004           | EXAMINER              |                  |
| PERKINS COIE LLP       |             |                      | BAUMEISTER, BRADLEY W |                  |
| PATENT-SEA             |             |                      | ART UNIT              |                  |
| P.O. BOX 1247          |             |                      | PAPER NUMBER          |                  |
| SEATTLE, WA 98111-1247 |             |                      | 2815                  |                  |

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                   |                                   |  |
|------------------------------|-----------------------------------|-----------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/637,177     | Applicant(s)<br>YAMAMOTO, KATSUMI |  |
|                              | Examiner<br>B. William Baumeister | Art Unit<br>2815                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-10, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-10, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Teshima '342. See e.g., FIGs 1a and 1b and the associated discussion appearing in the BACKGROUND section.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 2, 3, 6, 7, 9, 10, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teshima as applied to claims above.
  - a. Regardless of whether Teshima discloses the additional structures or specific compositions recited in these claims, their respective uses in conjunction with micro-lenses were well known to those of ordinary skill in the art at the time of the invention. It would have been obvious to such skilled artisans to have employed them for their conventional purposes.

***Response to Arguments***

5. Applicant's arguments filed 9/28/04 have been fully considered but they are not persuasive.

a. Applicant has amended the independent claims to recite that the micro-lenses are manufactured to be purposefully larger and/or taller than the first set of micro-lenses.

Applicant has also argued that this amendment overcomes the rejection because the Teshima reference teaches that the variation in the micro-lenses' shapes and size is not purposeful, but rather an unwanted by-product of inferior manufacturing process.

b. However, since it was known that the formation of micro-lenses resulted in unwanted size differences, the choice to employ the Teshima process constitutes a conscious decision to manufacture the lenses such that the second set of micro-lenses is "purposefully" (albeit undesirably) larger and/or taller than the first set."

c. More importantly, in light of the well-established product-by-process and intended-use doctrines, the examiner recommends Applicant amend the claims towards any potential distinctions that are structural in nature as opposed to distinctions relating solely to the underlying processes or intentions.

***Contact Information***

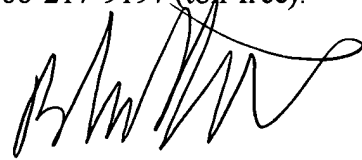
Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. William Baumeister whose telephone number is (571) 272-1722. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Thomas can be reached on (571) 272-1664. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2815

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**BRADLEY BAUMEISTER**  
**PRIMARY EXAMINER**



B. William Baumeister  
Primary Examiner  
Art Unit 2815

October 7, 2004